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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,118	12/17/2001	Linda G. Cote'	57319US002	2493

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,118

Applicant(s)

COTE' ET AL.

d05

Examiner

Rabon, Sergeant

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/12/02, 2/24/03</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A: Within claim 1, heteroalkoxy has been misspelled.

B: Within claim 1, the language, "the fluorochemical urethane compound", lacks antecedent basis.

C: It is unclear what definitive limitation is set forth by the subjective terminology, "capable of further improving the oil- and/or water repellency or soil/stain release properties of a fibrous substrate treated with the fluorochemical urethane compounds". It is unclear what level of improvement is mandated by the language; therefore, it is unclear what components will satisfy the condition as claimed.

D: Applicants have stated that polyoxyalkylene compound (a)(2) and the auxiliary compound (b) are hydrophilic; however, within claims 6 and 10, applicants specify that these compounds comprise polymers containing oxypropylene and oxytetramethylene linkages. Within the art, these types of compounds are known to be hydrophobic, as opposed to hydrophilic. Therefore, it is unclear how the language of claims 6 and 10 further limit claim 1.

E: Within claims 6 and 10, applicants have specified homopolymers and copolymers of polymers (i.e., polyoxyethylene, etc.); it is questioned if this is correct.

F: Within claim 7, the language, "said second auxiliary component", lacks antecedence.

G: Within claim 8, the language, "said second component polyisocyanate", lacks antecedence.

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H: The species within line 2 of claim 9 should be recited in the alternative.

I: Within claim 11, applicants have failed to specify the basis and type for the claimed percent values. Are the values based on the compound (a)(1)? Are the percents weight or mole percents? Furthermore, it is implicit within claim 11 that the specified reactive compounds must be isocyanate reactive.

J: Within claim 12, the language, "isocyanate groups of said auxiliary compound" lacks antecedence. There is no requirement within claim 1 that the second component contain isocyanate groups.

K: Within claims 14 and 15, "said first component urethane" and "said second auxiliary compound" lack antecedence.

L: Within claims 20 and 25, the type and basis of the claimed percent values has not been set forth.

M: Within claim 27, the recited coating composition lacks antecedence from claim 13. There is no reference to a coating composition within claim 13.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6, 11, 16, and 18-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Fan et al. ('088).

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The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

4. Fan et al. disclose a chemical composition comprising a urethane derived from compounds that meet applicants' components 1, 2, 3, and 4. Furthermore, patentees disclose at column 8, lines 40+ that the composition can contain additional urethane compounds. The position is taken that these additional compounds meet applicants' claimed second component.

5. The relied upon subject matter within Fan et al. is considered to have an effective date prior to March 26, 2002.

Any inquiry concerning this communication should be directed to Rabon Sergent at telephone number (571) 272-1079.

R. Sergent
March 21, 2004


RABON SERGENT
PRIMARY EXAMINER